

REMARKS

1. **Status of the Claims**

Currently, Claims 1-4, 7-10, 14-23 and 29-34 are pending in the application. Claims 1-4, 7, 9, 10, 15-18, 20-23 and 29-34 have been rejected, and Claims 8, 14, and 19 have been objected to as being allowable, but dependent from a non-allowable base claim. Applicant has amended Claim 1 to include the limitations of Claim 8, has amended Claims 32-34 for formal reasons, and has deleted Claims 8, and 29-31.

2. **Objections to the Claims**

The Examiner has objected to Claims 29, and 32-34 based on some minor informalities with the claims. Applicant has amended the claims to remove the informalities, and therefore submits that the Examiner's objections have now been overcome.

3. **Rejection Under 35 U.S.C. §112**

The Examiner has rejected Claims 22, and 30-34 under 35 U.S.C. §112, based on the contention that they are indefinite as written. Applicant has amended the claims and the specifications to better clarify the invention, and therefore submits that the Claims should now be in condition for allowance.

The Examiner has rejected Claims 22 and 34 under 35 U.S.C. 112, first paragraph and second paragraph, based on the contention that the means-plus-function limitation lacks explicit or implicit structure, materials or acts that correspond to the means-plus-function language. Applicant respectfully traverses the Examiner's rejection of Claims 22 and 34. The means for applying physical or chemical gradients, or potentials to the microelectrode system of the present

invention is clearly shown in Fig. 5a, as the laterally-extending electrode terminals labeled as element 14. Although the original specification did not specifically recite the structural label for those elements, electrode terminals are well known structures to those of ordinary skill in the art. The drawing in Fig. 5a, combined with the specific description of the function of that element on Page 9 of the specification, is more than sufficient to allow one of ordinary skill in the art to make and use the present invention, since electrode terminals are commonly known structures.

Nevertheless, to further clarify the present invention, Applicant has amended the specification to specifically recite the name of the structure already shown in Fig. 5a. Applicant has specifically amended the specification to label the structural elements 14 as “terminals,” as would be known by one of ordinary skill in the art. Since these structures were already shown in Fig. 5a, Applicant submits that the amendments to the specification add no new matter to the application, and simply clarify the structural label of the elements shown in Fig. 5a.

The Examiner has also rejected Claims 30-33 based on other informalities with the claims. Specifically, Claims 30 and 31 had an incorrect dependency, and Claims 32 and 33 required clarification of the wording of the claims. Applicant has deleted Claims 30 and 31, rendering that rejection moot, and will address the remaining rejections below.

The Examiner has rejected Claim 32, stating that it is not clear whether the wording of the claim defines a product-by-process limitation. Claim 32 has been amended above to recite that the metallic layer “comprises an organic conducting layer” Applicant submits that this amendment makes it clear that the organic conducting layer is a separate and distinct layer within the system.

The Examiner has also rejected Claim 33, stating that it is not clear whether the conducting layer is actually in the microelectrode system. Applicant has amended the claim

language to specifically recite the conducting layer as a part of the laminated structure.

Based on the above, Applicant submits that all of the Examiner's §112 issues have now been addressed and overcome.

4. Rejection Under 35 U.S.C. §102/103

The Examiner has additionally rejected Claims 1-3, 16-18, and 21 as being anticipated by one or more prior art references. Furthermore, the Examiner has also found that Claims 1, 2, 4, 7, 9-10, 15-17, 20-21, 23, and 29 are unpatentable over one or more prior art references.

Applicant continues to traverse the Examiner's rejections. Nevertheless, the Examiner has already found that Claims 32-34 define patentable subject matter, and that Claims 8, 14 and 19 would be allowable if rewritten in independent form. In response, Applicant has deleted Claims 8 and 29-31, and included the limitations of Claim 8 in Claim 1. Therefore, Applicant submits that independent Claims 1, and 32-34 should now be in condition for allowance. Furthermore, the remaining rejected claims, namely claims 2-4, 7, 9-10, 14-21, and 23, all depend from one of the independent claims, and should therefore also now be in condition for allowance.

5. Conclusion

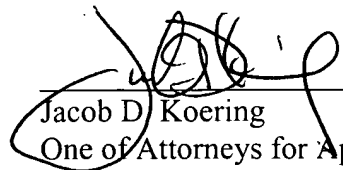
Based on the above, Applicant submits that all of Claims 1-4, 7, 9-10, 14-23, and 32-34 should now be in condition for allowance. Therefore, reconsideration and passage to allowance is respectfully requested.

Should anything further be required, a telephone call to the undersigned, at (312) 226-1818, is respectfully invited.

Respectfully submitted,

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Dated: April 5, 2004



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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on April 5, 2004.

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